

Remarks/Arguments:

Claim 3-6, newly presented, are pending, with claims 3 and 5 being independent, claim 4 being dependent on claim 3, and claim 6 being dependent on claim 5.

Claims 1 and 2 are canceled, without prejudice or disclaimer.

Present (new) claim 3 corresponds to the claim 1, previously presented. Present (new) claim 5 incorporated claim 1, as previously presented, and subject matter described in the instant specification (paragraph bridging pages 7 and 8, and page 8 Table 3). Present claim 4 limits the "adhesive sealant" of claim 3 by incorporating the sealant into an "automobile door," as described in the instant specification (*e.g.*, paragraph bridging page 2 and 3). Present claim 6 likewise limits the adhesive sealant of claim 5 by its incorporation to an automobile door.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Reconsideration is requested.

According to the statement of rejection (Office Action, page 3), claim 1 allegedly fails to satisfy the written description requirement of §112, ¶1, because:

There is no disclosure to support the recitation of "consist," to exclude other constituents. No example is provide that is so limiting, nor description that clearly indicates such limitation.

The rejection cannot be maintained because it is based on a clearly erroneous understanding and application of §112, ¶1, written description requirement, as well as clearly erroneous findings of fact.

Rejected claim 1, and the present claims, use the *transitional phrase* "consisting of," which has a meaning *defined by law, i.e.*, it "excludes any element, step, or ingredient not specified in the

claim," except in trace amounts. MPEP 211.03. As such, there is no need for the specification to describe, explicitly or implicitly, any *exclusionary intent*, contrary to what is alleged in the statement of rejection. See *In re Janakirma-Rao*, 135 USPQ 893 (CCPA 1963), and *Ex parte Davis*, 80 USPQ 448 (POBdApp 1948). Applicants are doing no more than narrowing the claims (*i.e.*, excluding subject matter previously claimed) to avoid the prior art, which requires no supporting disclosure of exclusionary intent. *In re Johnson*, 194 USPQ 187 (CCPA 1977). Alleging that a lack of exclusionary disclosure

has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute ... the "written description" in the ... specification supported the claims in the absence of the [narrowing] limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not ... claiming "new matter."

194 USPQ at 1196. In the present case, Applicants are doing nothing more than the appellants in *Johnson*, *i.e.*, Applicants are merely "excising the invention of another, to which they are not entitled, and [so] are not ... claiming 'new matter.'" Accordingly, withdrawal of the rejection is in order.

Moreover, even assuming, *arguendo*, §112, ¶1, descriptive support for "consisting of" were necessary, such support is, in fact, provided by the instant application, *i.e.*, when the correct standards for satisfaction of §112, ¶1, descriptive support are applied. "Clearly the observation of

a lack of literal support does not, in and of itself, establish a *prima facie* case of for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

'[T]he test for sufficiency of support . . . is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." [Citations omitted.]

Vas-Cath Inc. v. Mahukar, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Presence or absence of literal support is not the issue. *Ex parte Harvey*, 3 USPQ2d 1626 (Bd. Pat. App. & Inter. 1987). To comply with the written description requirement the original disclosure need not describe the "invention claimed . . . *in ipsius verbis*." *In re Edwards*, 196 USPQ 465, 468 (CCPA 1978).

In order to comply with the written description requirement . . . the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented. *See Eiselstein*, 52 F.3d at 1039, 34 USPQ2d at 1470.

All Dental Prodx LLC v. Advantage Dental Products Inc., 64 USPQ2d 1945, 1948 (Fed. Cir. 2002).

As described in the present specification (page 4, second complete paragraph) (emphasis added):

The sealant for automobile doors, according to the present invention, comprises the above partially crosslinked NBR and/or SBR, a plasticizer and a filler as essential components. Preferably, . . . uncrosslinked synthetic rubber . . . is additionally

blended to these essential components. Optionally . . . an antioxidant . . . may be appropriately added.

Accordingly, given that compliance with the written description requirement of §112, ¶1, does not require the original disclosure to described the "invention claimed . . . *in Ipsis Verbis*," *Edwards*, 196 USPQ 468, the aforesaid teachings of the present specification "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Vas-Cath Inc.*, 19 USPQ2d at 1116; that is, the present specification—by expressly describing an adhesive sealant constituted by the same ingredients recited in the claims—to which the claimed sealant is "consisting of"—as essential, preferable, and optional ingredients, the written description of §112, ¶1 is satisfied because the present specification "reasonably conveys to the artisan that the inventor had possession . . . of the later claimed subject matter." *Id.*

In view of the foregoing remarks, even assuming that compliance with the written description requirement §112, ¶1, requires written descriptive support in the specification, to comply with §112, ¶1, such written descriptive disclosure is, in fact, found in the present specification. The rejection is, therefore, overcome, and withdrawal of the rejection appears to be in order.

Claim 1 is rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent 6,184,296 (Obrecht). Reconsideration is requested.

To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). The

"absence" from a prior art reference of a single claim limitation "negates anticipation". *Kolster Speedsteel AB v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986).

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). When

it is necessary to select . . . and combine . . . from . . . list[s] of alternatives . . . to arrive at a specific composition, anticipation can only be found if the . . . [lists] are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

MPEP 2131.02.

The "adhesive sealant" of rejected claim 1, and the present claims, excludes non-recited ingredients, except in trace amounts, by virtue of reciting the transitional phrase "consisting of." *Janakirma-Rao, supra. Davis, supra.*

Obrecht [abstract] discloses "rubber mixtures containing modified rubber gels" (emphasis added). As taught by Obrecht (col. 1, lines 50-51, and col. 2, lines 26), "Rubber gels are taken to mean microgels (A) produced by crosslinking . . . uncrosslinked rubber starting products." Specific uncrosslinked rubber starting products, *e.g.*, BR, ABR, and SBR, are listed in the table bridging columns 1 and 2 of the reference. In fact, these crosslinked-rubber gels—which are indispensable components of the "rubber mixtures" disclosed in Obrecht—are relied on by the rejection to meet "the first rubber component" of the rejected claim (Office Action, page 3). The reliance is misplaced, however, since the indispensable presence of the crosslinked-rubber gels in the "rubber

mixtures" disclosed in Obrecht—and relied on to anticipate the presently claimed "adhesive sealant"—are excluded from the scope of the rejected (and present) claims in view of the transitional phrase "consisting of."

More precisely, the "rubber mixtures" disclosed in Obrecht must contain the "microgels (A) produced by crosslinking," which can only mean fully crosslinking, "uncrosslinked rubber starting products." Complete crosslinking is, of course, inherent in Obrecht given: (1) the disclosed use of the "rubber mixtures ... for the production of vulcanizates which have an unusually strong reinforcing action ... [and] exhibit unusually low dynamic damping at relatively elevated temperatures. ... [so] are thus particularly suitable for the production of low rolling resistance motor vehicle tire treads" (Obrecht, Abstract); and, more importantly, (2) nothing in the reference teaches or suggests, explicitly or implicitly, that partial crosslinking of uncrosslinked rubbers, let alone the uncrosslinked rubbers themselves, would produce the crosslinked-rubber gels disclosed in the reference. The "presumed knowledge" of one skilled in the art "does not grant a license to read into the prior art reference teachings that are not there." *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997).

Obrecht (column 2, line 15, through column 3, line 22) further teaches (emphasis added):

Crosslinking to produce the rubber gels proceeds in the latex state ... The rubbers may also be crosslinked in the latex form to yield rubber gels by post-crosslinking with chemicals having a crosslinking action. ... Particle enlargement by agglomeration may optionally also be performed before, during or after post-crosslinking in the latex form.

Rubbers which were produced in organic solvents may also be used as starting products for the production of the rubber gels. In this case, it is advisable to emulsify the solution of the rubber in water, optionally with the assistance of an emulsifier, and subsequently to crosslink the resultant emulsion with suitable crosslinking agents before or after removal of the organic solvent. Suitable crosslinking agents are those mentioned above.

Accordingly, water—present in the "latex" state/form of the rubber or in which the rubber is emulsified—is indispensably present in the "rubber mixtures" of Obrecht, which allegedly anticipate the presently claimed invention. On the other hand, water and other solvents—being non-recited elements—are excluded from the presently claimed "sealant" "consisting of" the recited elements. *Janakirma-Rao, supra. Davis, supra.*

In fact, exclusion of a solvent is expressly taught in the subject application (pages 5-6), *i.e.*, "the present invention will be explained in more detail by way of [invention] Example and Comparative Example," the comparative example being a "butyl rubber base sealant containing a solvent which is in the form of [a] paste at ordinary temperatures" (emphasis added). *See also* ¶ [0003] of the instant specification.

Accordingly, the "absence" from Obrecht of a composition "consisting of" the limitations recited in the rejected and present claims "negates anticipation" of the rejected and present claims by the reference. *Kolster Speedsteel AB*, 230 USPQ at 84. Since each, and only each, limitation of the presently claimed invention does not "identically appear" in the Obrecht disclosure, the reference

fails to anticipate the presently claimed invention. *Gechter*, 43 USPQ2d at 1032. Withdrawal of the rejection appears to be in order.

Moreover, with all due respect, the anticipation rejection §102(b) cannot be maintained because it impermissibly uses hindsight reconstruction to select out of context various teachings of Obrecht and combine them in a manner neither taught nor suggested in the reference. *See In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The rejection alleges (Office Action, page 4) that arrangement of the compositional components found in rejected claim 1 is met by the disclosure in Obrecht at column 1, lines 37-46, *i.e.*;

The present invention accordingly provides mixtures prepared from at least one rubber gel . . . (A) and at least one rubber containing double bonds (B) . . . optionally together with further fillers and rubber auxiliary substances.

However, as readily appreciated from the allegedly anticipating text disclosure, each and every claim limitation does not "*identically* appear" in the reference as arranged in rejected claim 1 (and the present claims). *Gechter*, 43USPQ2d at 103 (emphasis added) and *Jamesbury Corp. supra*. Moreover, the lists of alternatives for components (A) and (B)—from which the rejection arbitrarily selects in order to meet the limitations on rejected claim 1—are neither sufficiently limited (there are well over 50 alternatives (A) and well over 20 alternatives (B)) nor sufficiently delineated ((A) being delineated broadly a crosslinked-rubber microgel, and (B) being broadly delineated natural synthetic rubber), to constitute an anticipation of the presently claimed invention. *Ex parte A, supra*. MPEP 2131.02.

In view of the foregoing remarks, the rejection of claim 1 under §102(b), as allegedly anticipated by Obrecht, is overcome. Withdrawal of the rejection appears to be in order.

It should also be pointed out present (new) claims 5 and 6 limit the claimed "sealant" to have certain properties, i.e., "wherein the sealant exhibits hot creep characteristics of (i) no change under a 0.5g load at 80°C for 24 hours and (ii) cohesive failure under a 1.0g load at 80°C for 3 hours." Properties of the claimed invention must be taken into consideration when comparing the claims against the prior art. *In re Estes*, 164 USPQ 519 (CCPA 1970). "From the standpoint of patent law, a compound and all of its properties are inseparable." *In re Papesch*, 137 USPQ 43, 51 (CCPA 1963). The properties to which claims 5 and 6 are expressly limited are neither taught nor suggested by Obrecht.

It should also be pointed out that present (new) claims 4 and 6 incorporate the claimed "adhesive sealant" into an automobile door. On the other hand, Obrecht (column 6, lines 1-5)—teaching only use of its "rubber mixtures" as "rubber vulcanizates ... suitable for the production of moldings, for example for the production of cable sheathing, tubes, drive belts, conveyor belts, roller coverings, tires, in particular tire treads, shoe soles, sealing rings and damping components"—neither teaches nor suggests any use as an adhesive sealant, let alone an adhesive sealant incorporated into an automobile door, as presently claimed.

Accordingly, limitations found in present claims 4-6 render these claims independently patentable, i.e., in addition to the reasons (provided above) that present claims 3 and 4-6 are patentable over Obrecht.



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Favorable action is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Player", written over a horizontal line.

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